

REMARKS

By this Amendment, Applicants amend claims 1, 3, 7, 8, 10, 19 and 21-25 and add new claims 26 and 27. Claims 1-27 are therefore pending. In the Office Action of August 25, 2004,¹ claims 23-25 were objected to for informalities; claims 1-23 and 25 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Pub. No. 2003/0079197 (“*Pannala*”); and claim 24 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Pannala*. Applicants address the objection and rejections, as well as the new claims, below.

Objection to claims 23-25

The Examiner objected to claim 23-25 for informalities (Office Action “OA” at 2). Applicants submit that the Examiner’s objection is overcome by the amendments to claims 23-25 made herein, and therefore request withdrawal of the objection.

Rejection of claims 1-23 and 25 under 35 U.S.C. § 102(e)

Applicants traverse the rejection of claims 1-23 and 25 under 35 U.S.C. § 102(e) because *Pannala* fails to anticipate the claims. In order to properly anticipate Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim[s].” *See* M.P.E.P. § 2131. Finally, “[t]he elements must be arranged as required by the claim.” *Id.*

With regard to independent claim 1, *Pannala* does not teach at least “establishing guidelines for designing the element, the guidelines including information reflecting attributes of

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

at least one of the system and the element,” as currently claimed. The Examiner notes *Pannala*’s disclosure of a netlist. The netlist described by *Pannala* does not teach or suggest “establishing guidelines” as recited in claim 1. According to *Pannala*, “[a] netlist is a collection of information identifying component pairs and their interconnection” (¶ 0018; Figs. 2, 3). A “collection of information identifying component pairs and their interconnection” does not constitute “guidelines including information reflecting attributes of at least one of the system and the element,” as claimed. Indeed, neither *Pannala*’s disclosure of a netlist, nor any other disclosure in the reference, teaches or suggest the “establishing” feature of claim 1.

Because *Pannala* does not teach or suggest each and every element of claim 1, as a matter of law, it cannot anticipate this claim. As such, the rejection of claim 1 under 35 U.S.C. §102(b) based on *Pannala* should be withdrawn.

Independent claim 10, as currently presented, recites *inter alia*:

accessing guidelines for designing the structure, the guidelines including recommendations for routing the elements in the structure.

Pannala does not teach at least the above-noted recitations. *Pannala*’s netlist, which is a “collection of information identifying component pairs and their interconnection” does not constitute “guidelines including recommendations for routing the elements in the structure,” as claimed. For at least this reason, *Pannala* fails to teach the “accessing” feature of claim 10. Because *Pannala* fails to teach each and every feature of claim 10, *Pannala* cannot anticipate claim 10.

Independent claim 19, as currently presented, recites a combination of elements including:

one or more guidelines for designing the element, the guidelines including at least one recommendation for routing the element in the system.

Pannala fails to teach at least the above-noted recitations. *Pannala*'s netlist does not teach or suggest the claimed "guidelines." *Pannala*'s netlist does not include "at least one recommendation for routing the element in the system," as claimed. Instead, *Pannala*'s netlist is merely a "collection of information identifying component pairs and their interconnection." For at least this reason, *Pannala* fails to teach the "guidelines" recited in claim 19. Because *Pannala* fails to teach each and every feature of claim 19, it cannot anticipate that claim.

Each of independent claims 21 and 22, although of different scope, includes recitations similar to those of claim 19 discussed above. In particular, claim 21 recites, *inter alia*, "establishing guidelines for designing the element, the guidelines including at least one recommendation for routing the element in the system;" and claim 22 recites, *inter alia*, establishing routing guidelines including at least one recommendation for routing the element in the system." For at least reasons similar to those presented above in connection with claim 19, *Pannala* does not anticipate claims 21 and 22.

Claims 2-9 and 23 depend upon claim 1; claims 11-18 depend upon claim 10; claim 20 depends upon claim 19; and claim 25 depends upon claim 21. Dependent claims 2-9, 11-18, 20, 23 and 25 are distinguishable from *Pannala* for at least reasons similar to those presented above in connection with base claims 1, 10, 19 and 21.

Moreover, *Pannala* does not teach or suggest at least "receiving one or more revised guidelines for designing the system ... and determining a revised routing pattern in the system for the element based on the diagram and the revised guidelines," as recited in claim 3. The Examiner notes (OA at 3, 7) that *Pannala* describes "resizing and repositioning one or more symbols" (page 3, ¶ 0038; see Fig. 9). Resizing and repositioning a symbol in a layout to increase the directness of connections, as mentioned by *Pannala*, does not, however, constitute

“receiving revised guidelines for designing a system ... and determining a revised routing pattern in the system for the element based on the diagram and the revised guidelines,” as claimed.

Further, *Pannala* does not disclose receiving a revised netlist, which the Examiner equates with guidelines. For at least these reasons, *Pannala* fails to teach each and every element recited in claim 3. Claim 12, although of different scope, includes features having some relation to those discussed above in claim 3. For at least the reasons discussed above for claim 3, *Pannala* fails to anticipate claim 12. In addition, *Pannala* does not teach at least establishing guidelines including “recommendations for routing the element through the system,” as recited in claim 23.

Because *Pannala* fails to anticipate claims 1-23 and 25, the rejection of these claims under 35 U.S.C. § 102(e) based on *Pannala* should be withdrawn. Applicants thus request withdrawal of the § 102(e) rejection of claims 1-23 and 25 and the timely allowance of these pending claims.

Rejection of claim 24 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claim 24 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Pannala*. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Pannala does not disclose or suggest at least establishing guidelines for designing an element “by prompting a user to answer one or more questions,” as recited in claim 24. While acknowledging that *Pannala* fails to disclose “prompting a user to answer one or more questions in establishing the guidelines,” the Examiner alleges that “it would have been obvious . . . that establishing guidelines may be created through system prompt/ user input” (OA at 6). According to the Examiner, *Pannala*’s “use of a user interface with input and output devices suggests the possibility of a system prompt and a user response . . .” (OA at 6). Applicants disagree with the Examiner’s interpretation of *Pannala*.

Although Fig. 10 of *Pannala* depicts input and output devices, *Pannala* in no way suggests that such devices are used to establish guidelines for designing an element “by prompting a user to answer one or more questions,” as recited in claim 24. The disclosure of input and output devices does not in and of itself signify that those devices are used to establish guidelines for designing an element “by prompting a user to answer one or more questions” as claimed. Indeed, *Pannala* is silent about establishing guidelines for designing an element “by prompting a user to answer one or more questions.”

Furthermore, the Examiner’s allegations do not establish that a skilled artisan would have modified *Pannala* to include the features of claim 24 missing from the reference. Applicants remind the Examiner that determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to combine/modify references must be proved with “substantial evidence” that is a result of a “thorough and

searching” factual inquiry. See *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action does not show, by substantial evidence, that a skilled artisan considering *Pannala*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify the reference in a manner resulting in Applicants’ claimed combination. The statement that “use of a user interface with input and output devices suggests the possibility of a system prompt and a user response . . .” does not show a motivation or suggestion for modifying *Pannala*. Applicants call attention to M.P.E.P. § 2143.01, which makes clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not show that *Pannala* “suggests the desirability” of a modification resulting the combination of elements recited in claim 24, and it provides no objective reason from the reference for such a modification. The Office Action does not show a proper motivation to be present in the relied-upon reference or in the knowledge generally available to one skilled in the art. Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited reference and that, instead, teachings of the present application were improperly used to reconstruct the prior art.

For the foregoing reasons, the rejection of claim 24 under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection of claim 24 and the timely allowance of that claim.

New claims

New claim 26 depends from claim 21 and is not anticipated or rendered obvious by *Pannala* for at least reasons similar to those set forth above in connection with claim 21.

Applicants further submit that *Pannala* does not teach or suggest all of the features recited in new claim 26. Applicants therefore request the timely allowance of new claim 26.

In addition, new independent claim 27 is not anticipated or rendered obvious by *Pannala*. Claim 27 recites, *inter alia*, “establishing guidelines for designing the element, the guidelines including at least information reflecting a geometry of the system.” *Pannala* fails to teach or suggest at least this feature. Applicants therefore request the timely allowance of new claim 27.

Conclusion


The claimed invention is neither anticipated nor rendered obvious in view of the art cited against this application. Applicants request the Examiner’s reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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